



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/549,330

09/12/2005

Gary N. Mills

103477-0007

6689

35940

7590

12/31/2008

ATER WYNNE LLP

222 SW COLUMBIA, SUITE 1800

PORTLAND, OR 97201-6618

EXAMINER

SZMAL, BRIAN SCOTT

ART UNIT

PAPER NUMBER

3736

MAIL DATE

DELIVERY MODE

12/31/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/549,330	Applicant(s) MILLS ET AL.	
	Examiner Brian Szmaj	Art Unit 3736	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-11.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Max Hindenburg/
 Supervisory Patent Examiner, Art Unit 3736

Continuation of 11. does NOT place the application in condition for allowance because: The Applicants argue the prior art rejection of Alt fails to teach the current claim limitations. The Applicants further argue the Examiner has not given the broadest reasonable interpretation of the limitation "on an external surface of the body", in light of the specification and further cite Philips v. AWH Corp. The Examiner respectfully disagrees. Philips v. AWH Corp. clearly states that the Applicant can become their own lexicographer, as long as the Applicant provides a special definition in the specification to a word that ordinarily has a different definition. In this instance, the Applicant argues "on an external surface of the body" has been given a special definition in the specification, and the definition is inconsistent with the Examiner's interpretation of the phrase in view of the prior art of Alt. The Examiner again respectfully disagrees. The current specification does not provide a special definition to the phrase "on an external surface of the body". The phrase is defined as placing something on an external surface of a body. The current claim language can be interpreted as placing a device on an external surface of a rib cage, on an external surface of the skin, or even on an external surface of an organ. The Applicants then argue the current invention is directed towards a non-invasive device and method, while Alt is directed towards an invasive device requiring implantation. The Examiner would like to respectfully point out the current claim language is silent with respect to whether or not the device and method is invasive or non-invasive because a non-invasive device is not being claimed. The Applicants then argue that no limitation needs to be imported from the specification to interpret the limitation "on the external surface of the body" consistent with the Applicants' specification. The Examiner again respectfully disagrees. The specification provides teaching that the device is placed on the skin surface of a patient, however, the claim language is broader than the limitation in the specification. The current claim language can be interpreted as placing a device on an external surface of any type of body, not just the skin. In order to interpret the claim language as only placing a device on the external surface of the skin would constitute reading a limitation from the specification into the claim, which is prohibited. The Applicants then argue the asserted claim scope is neither reasonable in view of, nor consistent with, the Applicants' specification and is therefore improper, while again citing Philips v. AWH Corp. The Examiner again respectfully disagrees. As noted above, the Applicants arguments regarding Philips v AWH Corp. are not persuasive because no special definition was provided in the specification regarding "on an external surface of the body". Since "on an external surface of the body" has not been given any special definition in the specification other than the ordinary meaning of the phrase, the phrase can be reasonably interpreted as broadly as possible. As stated above, the current claim language can be interpreted as placing a device on an external surface of any body, including body structures including a rib cage, the skin, an organ, or a limb; all of which are reasonable interpretations of the phrase to one of ordinary skill in the art. The Applicants argue the Examiner is taking Official Notice. The Examiner is not taking Official Notice. As stated above, the claim language as currently written can be broadly interpreted as placing the device under the skin on top of the rib cage. Furthermore, as stated above, the claim language is silent with respect to the device being invasive or non-invasive. The Applicants further argue their invention utilizes electrically conductive gel to couple the electrodes to the body surface. Again, the Applicants are arguing elements that are not claimed. Per the reasons set forth above, the rejection is being maintained.